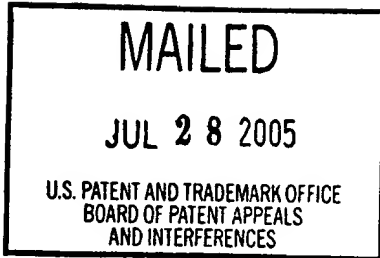


The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BILL KITCHEN, GINGER B. MOSES,
RALPH AU, CLARENCE M. BRINGARDNER, and
KENNETH W. BRADLEY, III



Appeal No. 2005-0778
Application No. 09/867,587

On Brief

Before THOMAS, DIXON, and MACDONALD, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 34-53,
which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

BACKGROUND

Appellants' invention relates to a bill availability notification and billing information request. An understanding of the invention can be derived from a reading of exemplary claim 34, which is reproduced below.

34. A method for presenting billing information via a network, comprising:

transmitting a notice according to an e-mail protocol, via a network, indicating availability of billing information;

transmitting a request according to a protocol other than an e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice; and

transmitting at least a portion of the billing information, via the network responsive to receipt of the request.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|----------------------|-----------|---------------|
| Hogan | 5,699,528 | Dec. 16, 1997 |
| Bezos et al. (Bezos) | 6,029,141 | Feb. 22, 2000 |

Claims 34-38, 40-47, and 49-53 stand rejected under 35 U.S.C. § 102 as being anticipated by Hogan. Claims 39 and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hogan in view of Bezos.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed July 28, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed May, 3, 2004) and to the reply brief (filed September 28, 2004) for appellants' arguments thereagainst. We note that appellants attempted to amend the claims at the time when the reply brief was filed to cancel various claims and amend others to be in independent form. The examiner denied entry of that amendment. Therefore, we will address the claims in their form at the time of the filing of the brief.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants have elected to group the claims into numerous separate groupings and the examiner disagrees with appellants' groupings. Therefore, we will select a single claim from each group, which appellants have set forth separate arguments for patentability, as the representative claim. Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could

have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. **Note** **In re King**, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); **In re Sernaker**, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). We address the claims in groupings to follow the order discussed in the brief.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear

in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); **cert. dismissed**, 468 U.S. 1228 (1984); **W.L. Gore and Associates, Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

We consider first the examiner's 35 U.S.C. § 102 rejection of claim 34 based upon the teachings of Hogan alone. From our review of the examiner's answer and the teachings of Hogan, we find that the examiner has established a ***prima facie*** case of anticipation of the recited three steps. Therefore, we look to appellants' briefs to rebut or show error therein.

The three recited steps require "transmitting a notice according to an e-mail protocol, via a network, indicating availability of billing information; transmitting a request according to a protocol other than an e-mail protocol, via the network, to

receive the billing information responsive to receipt of the notice; and transmitting at least a portion of the billing information, via the network responsive to receipt of the request." Appellants seem to paraphrase the examiner's position with respect to independent claim 34 correctly at pages 11-13 of the brief, but appellants argue that even if the examiner's analysis of Hogan is correct, the content of the e-mail with respect to a payment due notice is not a billing information availability notice. (Brief at page 15.) We do not find this argument persuasive since we find no difference between the non-functional descriptive material within either of the emails of Hogan or the claimed invention as long as there is a communication via email which then makes the user access/request the billing information in response thereto and receive the billing information.

We find that the transmission of the payment due notice and the subsequent logging onto the server computer through the internet in response thereto and transmission of billing data to be viewed by the user meets the language of independent claim 34. We find that Hogan teaches the invention as recited in independent claim 34, and dependent claim 36 grouped therewith. Similarly, we will sustain the rejection of independent claim 50 since the limitations thereto parallel those in independent claim 34 and we do not find a persuasive argument by appellants of claim 34. While Hogan discusses merely a single server 160, we find that Hogan

teaches that the server performs the varied functions recited in independent claim 50. Since the language of independent claim 50 does not require separate and distinct servers, we find that Hogan teaches the limitations as recited.

With respect to independent claim 40, the examiner relies upon the teaching of Hogan with respect to transmitting the billing information via email and utilizing an email receipt confirmation and to acknowledge when the bill is received and opened by the subscriber. (Answer at pages 5-6.) Appellants argue that Hogan does not teach that the subscriber ever requests billing information via an email transmission in response to an email that the billing information is available. (Brief at page 14-17.) The examiner maintains that when the subscriber opens the email “in essence” he or she is requesting to receive billing information. (Answer at page 10.) While we agree with the examiner that the opening of the email containing the billing information is similar to requesting to view the billing information, we cannot agree that Hogan teaches the email notice and email request and email transmission of the billing information, as recited in the language of independent claim 40 and its corresponding dependent claims 41 and 42. Similarly, we find that Hogan does not teach the corresponding system which is set forth in independent claim 51. Therefore, we cannot sustain the rejection of independent claims 40 and 51 and dependent claims 41 and 42.

With respect to independent claim 43, the examiner maintains that Hogan teaches the claimed method by accessing the billing information via a URL on the World Wide Web which is not via email. (Answer at page 10.) We agree with the examiner that the log-on, transmission and presentation of a GUI to "Receive and Pay Bills" would have been the notice, the subsequent selection of this choice by the user would have been a request to receive billing information and the display of the billing information would have been the transmission of at least a portion of the billing information in response to the request by the user. (Hogan at column 6, lines 9-31.) Appellants present discussions of various portions of Hogan and argue that Hogan does not teach the claimed invention. (Brief at page 17-20.) Appellants conclude that Hogan teaches a "pull" and a "push" embodiment. Appellants state that the pull embodiment is by a protocol other than email. (Brief at pages 19-20.) This is the embodiment that the examiner identifies in Figure 3 of Hogan, and we find that the user's interaction with the GUI teaches the claimed invention. Therefore, we find that Hogan teaches the invention recited in independent claim 43, and we will sustain the rejection of independent claim 43 and dependent claims 45 and 49 which appellants elected to group therewith.

With respect to independent claim 52, we find that Hogan similarly teaches a system which corresponds to the methodology discussed above with respect to independent claim 43, and we will sustain the rejection of independent claim 52 and dependent claim 53 which appellants have elected to group therewith.

With respect to dependent claim 35 and 44, taking claim 44 as the representative claim, we find the formatting of the data for presentation of the billing information with the GUI to receive and pay bills would have been in response to the user selecting the option to view the bills and pay them. The examiner relies upon columns 5 and 6 of Hogan as discussed above with respect to independent claim 43. (Answer at page 11.) Appellants argue that the examiner appears to ignore the express limitations of the claims. We disagree, and find that the examiner has merely addressed the broad claim limitations. Therefore, this argument is not persuasive, and we will sustain the rejection of claims 35 and 44. (The rejection of claim 41 was not sustained due to its dependency on independent claim 40.)

With respect to dependent claims 37 and 46, the examiner maintains that the email notice includes information indicating the location of the available billing information on the network. From our review of the teachings of Hogan, we find that

the both the email billing information and the WWW billing information contain an indication of the source of the data as the "EBSC" which we find to be an indication of a location on the network. Therefore, this argument is not persuasive, and we will sustain the rejection of claims 37 and 46.

With respect to dependent claims 38 and 47, we find no disclosure in Hogan of the transmission of a hyperlink but for at the initial registration. We find that the examiner's reliance upon this one time transmission of the hyper-link is unreasonable. Therefore, appellants' argument is persuasive and we cannot sustain the rejection of dependent claims 38 and 47 and their dependent claims 39 and 48. (Therefore, we need not address the rejection based upon 35 U.S.C. § 103 since the examiner does not rely upon the teachings of Bezos beyond teaching that a hyper-link can be an icon. Therefore, Bezos does not remedy the underlying deficiency.)


CONCLUSION

To summarize, while the decision of the examiner to reject claims 34-37, 43-46, and 53 under 35 U.S.C. § 102 is affirmed, the decision of the examiner to reject claims 38, 40-42, and 47 under 35 U.S.C. § 102 is reversed, and the decision of the examiner to reject claims 39 and 48 under 35 U.S.C. § 103 is reversed.


Appeal No. 2005-0778
Application No. 09/867,587

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


JAMES D. THOMAS)
Administrative Patent Judge)


JOSEPH L. DIXON
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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Appeal No. 2005-0778
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